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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,960	01/21/2004	Kazuya Hijii	17377	3891
23389 7590 05/07/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
			EXAMINER VRETTAKOS, PETER J	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/761,960

Applicant(s)

HIJII ET AL.

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The application is published application number: 2004/0172111. The publication is classified in US 607/101.

The action is final.

The effective filing date of this application (tentatively) is 1-29-03.

Pending claims as of 9-10-06 are 1-12.

Elected (without traverse) claims 1-4 and 11 are examined below.

Amendment dated 2-14-07.

The redundancy of the control circuit is noted.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Burnside et al. (6,511,478).

#### **Burnside discloses:**

1. An electric surgery apparatus comprising:

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a high frequency power generating unit (104, figure 2) capable of generating a high frequency power to treat living-body tissue;

a treatment unit (112) capable of treating the living-body tissue based on the high frequency power generated by the high frequency power generating unit;

an intermittent output control unit (146 and 136) for converting the high frequency power into intermittent output;

a subject tissue determining unit (140, col. 10:26-30) for determining subject tissue based on change of the high frequency power supplied to the treatment unit; and

an intermittent output setting unit (146 and 138) capable of setting output values and the number of times of output controlled by the intermittent output control unit based on the determined results of the subject tissue determining unit.

2. The electric surgery apparatus according to claim 1, wherein the subject tissue determining unit is adapted to determine the subject tissue to be the diameter of blood vessels (intended use language – see note below).

3. The electric surgery apparatus according to Claim 2, wherein the subject tissue determining unit is adapted to determine the subject tissue based on the maximal current value flowing to the subject tissue and the time up to the maximal current value (intended use language – see note below).

4. An electric surgery apparatus comprising:

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high frequency power generating means (104, figure 2) capable of generating a high frequency power to treat living-body tissue;

treatment means (112) capable of treating the living-body tissue based on the high frequency power generated by the high frequency power generating means;

intermittent output control means (146 and 136 and 142) for converting the high frequency power into intermittent output;

subject tissue determining means (140, col. 10:26-30) for determining subject tissue based on change of the high frequency power supplied to the treatment means; and

intermittent output setting means (146 and 138) capable of setting output values and the number of times of output controlled by the intermittent output control means based on the determined results of the subject tissue determining means.

11. An electric surgery apparatus comprising:

a high frequency power generating unit (104, figure 2) for generating a high frequency power;

a treatment unit (112) for treating living-body tissue based on the high frequency power generated from the high frequency power generating unit;

a detecting unit (140) for detecting change of the high frequency power supplied to the treatment unit;

an output setting unit (146 and 138) for setting the number of times of intermittent output and output values of the high frequency power based on the detected results from the detecting unit;

and a control unit (146) for controlling a high frequency power generated from the high frequency power generating unit based on the setting value set by the output setting unit.

Note: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Response to Arguments***

Applicant's arguments filed 2-14-07 have been fully considered but they are not persuasive. The Applicant discloses what Burnside's (6,511,478) counter (138) actually does (its intended use). The Applicant then discloses that the counter (138) does not do (an actual method/steps/process) what the Applicant claims. From this the Applicant then argues that each and every **element (structural; not a long phrase describing what the element does)** is not in the prior art and thus Burnside is not anticipating. In response the Office asserts that the counter (138) is a **structural element** that anticipates the Applicant's claimed **structural element** (part of the "intermittent output setting unit") notwithstanding Burnside's silence with regards to the long phrase toward

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the element's intended use used by the Applicant in claim 1. The Applicant cannot obviate an apparatus claim rejection based upon intended use language. Furthermore, arguments by Applicants that pivot on non-structural language provide no tangible structural difference to the Office enabling the Examiner to withdraw a rejection. Until specific tangible structure is determined missing in the prior art the claims will remain rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

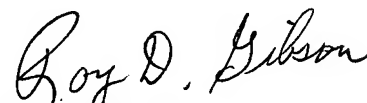

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
April 27, 2007



ROY D. GIBSON  
PRIMARY EXAMINER